

Appl. No. 10/722,820  
Amendment dated February 16, 2006  
Filed with RCE

PATENT

### REMARKS

Claims 1-58 are pending in the application. With entry of the instant amendment, claim 1 has been amended. This amendment adds no new matter.

The maintained rejections are addressed below in the order presented in the final Office Action mailed June 16, 2005.

#### *Rejection under 35 U.S.C. § 103*

Claims 1-58 remain rejected as allegedly obvious over Krishna *et al.* (referred to herein as "Krishna"). This rejection is respectfully traversed for reasons of record. The Examiner has not established a proper case of *prima facie* obviousness. Further, in the response dated October 17, 2005 in reply to the final Office Action, Applicants provided evidence from the teachings in the specification that the claimed compositions have unexpected properties. The claims are therefore additionally patentable over the cited art for this reason. This aspect was not addressed in the Advisory Action mailed November 9, 2005. Applicants respectfully request consideration of the additional arguments, which are reiterated below, in view of the filing of the RCE.

#### Pharmaceutical compositions of the invention have unexpected properties

Even assuming *arguendo* that Applicant's invention could be derived from the cited art, the invention is still patentable over this reference. The present claims are drawn to pharmaceutical compositions comprising primary N-hydroxylamines. Applicants have discovered that primary N-hydroxylamines have unexpected properties in comparison to cyclic N-hydroxylamines and their respective nitroxides. The primary N-hydroxylamines of the present invention delay cellular senescence. In contrast, cyclic-N-hydroxylamines (R<sub>2</sub>NOH) and their respective nitroxides protect against oxidative damage induced by H<sub>2</sub>O<sub>2</sub>, but do not delay cellular senescence. This property of primary N-hydroxylamines relative to prior art secondary hydroxy amine compounds is taught in the specification, *e.g.*, on page 46, lines 2-7; and page 48, lines 18-24; and page 49, lines 7-11. Applicant additionally teaches that this ability to delay cellular senescence emphasizes the remarkable feature of the primary N-hydroxylamines as antioxidants

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(page 49, lines 12-13). The presence of a property not possessed by the prior art is evidence of nonobviousness (*see, e.g.*, MPEP § 716.02(a)III). Accordingly, the claimed pharmaceutical compositions comprising primary N-hydroxylamines are patentable over the cited art.

*Obviousness type double-patenting*

Claims 1-58 were rejected for alleged obviousness-type double patenting over claims 1-57 of U.S. Patent No. 6,455,589. It is Applicants' understanding based on the Advisory Action mailed November 9, 2005 that this rejection has been overcome in view of the filing of a terminal disclaimer

Claims 1-58 were also rejected for allegedly obviousness type double patenting over claims 1-57 of co-pending application no. 10/713,432. No claims have been allowed in the co-pending application. It is applicant's understanding that if the provisional double patenting rejection is the only rejection remaining in this application, the rejection will be withdrawn in the instant application to permit the application to issue as a patent.

CONCLUSION

In view of the foregoing, Applicant believes all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,

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